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09/378,222	08/19/1999	JEFFRY JOVAN PHILYAW	PHLY-24.670	8863

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EXAMINER

THOMPSON, MARC D

ART UNIT PAPER NUMBER

2144

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/378,222

Applicant(s)

PHILYAW ET AL.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The response to the non-final action mailed on 4/5/2004 was received on 8/4/2004, and has been entered into record.
2. Claims 1-5, 7-14, and 16-20 remain pending.

#### *Priority*

3. This application is a continuation-in-part of Patent Number 6,098,106, previously pending application number 09/151,530.
4. The effective filing date for the subject matter defined in the pending claims originally disclosed in the parent application is 9/1/1998. All new matter disclosed in the present application and expressed in the claims is entitled to an effective filing date of 8/19/1999.

#### *Drawings*

5. The Examiner contends that the drawings submitted on 3/26/2001 are acceptable for examination proceedings.

#### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

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8. Claims 1-5, 7-8, 10-14, 16-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. (U.S. Patent Number 5,905,865), hereinafter referred to as Palmer, in view of Watanabe (U.S. Patent Number 6,163,803), hereinafter referred to as Watanabe, further in view of would have been obvious to one of ordinary skill in the art at the time the invention was made.

9. Palmer disclosed the invention substantially as claimed. Palmer disclosed the synchronizing of additional, related network retrieved data with digitally stored or received video and audio data. See Column 6, Lines 47-64. This retrieved information was enacted using Internet connection manipulation without human interaction, i.e. automatically. See Column 6, Lines 3-6, and Column 7, Lines 7-12. Palmer disclosed both combination of network locators in the actual video/audio signal, out of band broadcast of locators, and transmission of locators from remote sites. See Column 1, Lines 60-67, Column 2, Lines 25-33, Column 5, Lines 22-43, Column 5, Lines 59-62, and Column 8, Lines 5-19. Palmer also disclosed the use of an "intermediate node" (in the network) which received and redirected URL requests to the appropriate server(s) and compared decisions with the contents of user profiles. See Column 5, Lines 44-62, and Column 7, Lines 28-45. These URL designations were additionally resolved by DNS servers on the network in order to result in a physical address of a network device for information retrieval, providing yet another intermediate node involved with information retrieval. The "playing", "detecting", and "assembly" of the provided information embedded within multimedia information was described by Palmer in sufficient detail to enable one of ordinary skill in the art to implement the invention substantially as claimed.

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10. While Palmer disclosed the embedding of unique resource locators (URLs) (routing information) in broadcasted audio/video data (Column 5, Lines 59-62), Palmer remained silent as to specifics required to enact this type of functionality in a playback system as suggested in Column 8, Lines 5-23. While Palmer specifically disclosed the use of embedded address data in digitally represented data, the provision for stored multimedia file(s) and the extraction of URL address information from a digitally stored audio signal retrieved over a network, where the extracted information which was used to look up associated information in a centralized database was not expressly disclosed.

11. In the same art of network resource encoding and resultant information delivery, Watanabe disclosed a method and system for encoding network resource locators into stored and delivered digital data for display of remotely stored related information. See, inter alia, Column 4, Lines 28-55. Watanabe also disclosed the embedding/encoding of network resource designators specifically with audio signals, and the extraction of the network designators during playback of the audio information. See Column 6, Lines 8-26, and Column 9, Lines 53-56. The URL signal(s) were disclosed as part of the audible signal, resulting in a "perceivable tone", alternatively/preferably hidden from listener detection. See Column 6, Lines 59-65, and Column 7, Lines 44-49. Also see Column 18, Line 66 through Column 19, Line 2. The system also automatically retrieved the data according to the specified designator(s) where all nodes were present on a common network. See Column 9, Lines 36-42. Lastly, since Watanabe specifically provided this functionality "applied to any system which can transmit and receive an audio signal" (inter alia, Column 9, Lines 53-56), "as software to realize the foregoing processing procedure that is applied to a personal computer having both of the audio signal

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receiving function and the function for accessing to the web site and displaying web information” (inter alia, Column 11, Lines 38-46), “[it] can be applied to any system so long as it can record and reproduce an audio signal...[using] any audio signal recording medium” (inter alia, Column 13, Lines 6-16), and “a similar effect will be obtained by the invention even in case using any signal so long as it can be transmitted and received as an audio signal” (Column 19, Lines 2-5). it would have been obvious to one of ordinary skill in the art at the time the invention was made, when provided the Watanabe teachings and notoriously well known multimedia (video and/or audio) delivery over a network, that the source of any audio data, the audio transmitter, the audio receiver, the audio URL extractor, and URL information display device(s), all reside on the same computer network. After all, Watanabe specifically disclosed the use of an arbitrary recorded audio signal (inter alia, a personal computer having audio signal reproduction functionality (playback), URL extraction functionality, and web site retrieval and display (inter alia, Column 11, Lines 38-46, and Column 18, Lines 56-65). Watanabe specifically provided functionality “applied to any system which can transmit and receive an audio signal” (inter alia, Column 9, Lines 53-56), “as software to realize the foregoing processing procedure that is applied to a personal computer having both of the audio signal receiving function and the function for accessing to the web site and displaying web information” (inter alia, Column 11, Lines 38-46), “[it] can be applied to any system so long as it can record and reproduce an audio signal...[using] any audio signal recording medium” (inter alia, Column 13, Lines 6-16), and “a similar effect will be obtained by the invention even in case using any signal so long as it can be transmitted and received as an audio signal” (Column 19, Lines 2-5). Thus, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made, when provided the teachings above, minimally, in combination with notoriously well known multimedia (video and/or audio) file storage and delivery over a network, that the source of any audio data, the audio transmitter, the audio receiver, the audio URL/code extractor(s), code to URL lookup database, and URL information display device(s), all reside on the same computer network, for example the Internet. Also consider, all these functional elements may reside on the same computer (as expressly taught by Watanabe), itself inherently a part of the same network being used to obtain URL information. This logical commonality was inherent and required in order to allow machine addressing, and routing of requests or information to the terminals. Further provision for unique addresses for each terminal/node in the network was inherent. Otherwise, the physical routing of information was impossible. In short, if the terminals communicated using the network, they necessarily reside on the same logical network.

12. Incorporation of the Watanabe teachings into the teachings of Palmer would have been obvious to one of ordinary skill in the art for the simple reason that recited functionality drawn to the embedding of URL routing information into an audio stream or recording was fully described in such a way to enable the ordinary artisan to implement it. That is, the embedding of URL routing information and overall functionality drawn to delivery of audio/video associated/related information which was remotely stored provided by Palmer in Column 5, Line 59 through Column 6, Line 29, was fully described in detail in Watanabe, Column 4, Lines 28-55. The systems of Palmer and Watanabe were so similar, that practically identical synopsis of the inventions functionality regarding the inclusion of automatically retrieved Internet information to

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audio/video information were found in Palmer, Column 7, Lines 7-19, and Watanabe, Column 9, Lines 36-42.

13. Thus, since the teachings contain direct suggestion for combination, an individual one of the teachings would have resulted in an ordinary artisan being motivated to search the related arts for related teachings, that is, since the inventions were drawn to the same concept of associated Internet information delivery related with audio/video stored/transmitted information, and both inventions implemented a detailed description of encoding informational parameters in multimedia information for remote information retrieval, the identification and combination of these systems teachings was readily recognized by ordinary artisans. Thus, combination of the teachings would have been obvious to one of ordinary skill in the art at the time the invention was made, resulting in a system fully describing the extraction of URL information by a digitally stored information file retrieved/transmitted over a network, which specified a centralized database for information lookup residing on the same network the audio information was delivered over, i.e., “common network”. In regard to this “common network” discussion, it is noted that Palmer calls only for “a transmitter” and “broadcasting [multimedia]”, not specific network types necessarily in accordance with the preferred embodiment expressly disclosed in the best mode. See Palmer, Column 2, Lines 57 through Column 3, Line 43. In short, the provision for all the nodes of this combined system to be uniquely addressable, identifiable, and communicate using identical methodology (e.g., protocol usage), would have been a natural extension to the provided express teachings, minimally, to effect communication between system elements. This “integration” and/or “rearrangement” of modular parts falls well within the reasonable breadth of MPEP 2144.04(V).



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14. As a general matter, not only the specific teachings of a reference but also reasonable inferences which an artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and *In re Sherpard*, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*, 309 F.2d 738, 226 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 738, 1385 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, 193 USPQ 545 (CCPA 1977). Lastly, *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), clearly states “any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, reconstruction is proper”. In the instant case, the provision for the media assembler, media transmitter, media receiver, and media interpreter being present on the same logical/physical/common network, it would have been obvious to implement the methodology set forth in both teachings (Palmer and Watanabe) in an arbitrary type of network system effecting delivery of media and URL address(es) to end devices. The provision for a “common” network, where all nodes communicate in the same fashion with one another, is a trivial matter

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of integration and a minimal rearrangement of parts, and would have been obvious to one of ordinary skill in the art at the time of invention. See MPEP § 2144(V)(B).

15. Since, all limitations recited in claims 1-5, 7-8, 10-17, and 19-20, were disclosed by the combination of Palmer and Watanabe or would have been obvious to one with ordinary skill in the art at the time of invention, claims 1-5, 7-8, 10-17, and 19-20 are rejected.

16. Claims 1-5, 7-8, 10-14, 16-17, and 19-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Portuesi (U.S. Patent Number 5,774,666), hereinafter referred to as Portuesi, in view of Sherman (U.S. Patent Number 5,213,337), hereinafter referred to as Sherman, in view of Hudetz et al. (U.S. Patent Number 5,978,773), further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

17. Portuesi disclosed the embedding of URL information in a multimedia presentation, i.e., video with audio. See, inter alia, Column 2, Lines 22-38. The multimedia information was fully capable of being recorded and played back later, e.g., from a computer file, CD, or DVD. See, inter alia, Column 3, Lines 22-29. Further, referenced data was presented during rendering of the digitally stored multimedia information. See Column 2, Lines 39-59. Additional, URL association was enabled to occur specifically with audio information. See Column 3, Lines 30-35, and Column 5, Lines 5-10. The current asserted novelty drawn to a “user perceivable code” was also fully disclosed by Portuesi in Column 6, Lines 12-14; if the displayed hyperlink displays the actual URL address, the code was user perceivable. Thus, Portuesi disclosed the invention substantially as claimed.

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18. Portuesi did not disclose two important aspects of the presently claimed and disclosed invention. First, Portuesi did not specifically disclose the use of embedded audio signals which were recognizable to either the rendering machine or a human viewer to effect information retrieval. Second, Portuesi did not specifically disclose effecting information retrieval through the use of a predetermined identification number which corresponded to particular vendor products or services.

19. In regard to embedded audio signals, Portuesi did expressly disclose the encoding of URL information into the digital multimedia. See, inter alia, Column 9, Lines 5-8, and Figure 5, reference numeral 62. This resulted in a digital video signal (including audio) with embedded URL information, expressly disclosed as capable for digital storage on, inter alia, video disk(s). See, inter alia, Column 9, Lines 3-21. While Portuesi provided a single example for express encoding of the URL information into the multimedia file (Column 9, Lines 8-11), the language used was intentionally open-ended, suggesting other methods of information encoding as potentially used with the concept of invention. This would have motivated one of ordinary skill in the art at the time the invention was made to explore related teachings to find suitable means for embedding/encoding URL information into multimedia information.

20. In regard to information retrieval based on identification numbers which correspond to particular products or services, the natural extension of information relating to product(s) or service(s) being delivered to a requesting or unsolicited consumer in parallel with video and/or audio advertisements would have been obvious to one of ordinary skill in the art at the time of invention. This would have motivated one of ordinary skill in the art to explore product information retrieval techniques for this purpose; the linking of timely, relevant information

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corresponding to specific products or services during advertisements would have been recognized as desirable by one of ordinary skill in the art at the time of invention.

21. In the related art of television (video) and radio (audio) and the encoded use of audio controlling signals, Sherman disclosed the embedding of "substantially indiscernible" audio touch tones which effect functionality of a reception device and the use of these embedded tone(s) on recorded media. See, inter alia, Column 2, Lines 28-47, and Column 3, Lines 14-17. The audio enabled value embedding as disclosed by Sherman provided yet another type of information encoding for use in the Portuesi system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use encoding/embedding as described by Sherman in the encoding/embedding system described by Portuesi in order to encode strings of values in an audio/video presentation corresponding to URL network address(es) to correlate information with the currently rendered video/audio presentation. Since the audio tones were "substantially indiscernible", it is clear that the tones were "perceivable", and "user perceivable" as claimed.

22. In the related art of database information look-up, Hudetz disclosed the correlation of identification numbers with particular products and vendor information/offers concerning these product(s) using a network of remote database(s). See, inter alia, Column 3, Lines 17-24. It is also noted that Hudetz specifically disclosed two important details: (1) the encoded identification number(s) were in "human and/or machine readable form" (Column 3, Lines 27-28), and (2) an identification number was input which resulted in retrieval of an actual or logical network address (routing information, as claimed) through use of a [usually, remotely] located database for number to address look-up (Column 3, Lines 25-37). In regard to the latter, in light of these

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cited portions of the Hudetz teachings, the provision for UPC barcode operation for input of identification number(s) did not preclude the use of other types of input device(s), methods, human or machine actuated input, or specific type(s) of alphanumeric string(s) which resulted in arbitrary identification number(s) to physical or logical network address mapping. See Column 3, Lines 25-37. That is, the use of UPC numeric codes scanned by a peripheral reading device was only one way to achieve the invention as described; a numerical value corresponding to the designated information for database lookup was the crux of the invention as disclosed.

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Portuesi and Sherman providing embedded information within multimedia presentations with the numerical to network address correlation provided by Hudetz, for example, in order to minimize the amount of information added to any given stored or compiled multimedia presentation. Bandwidth conservation and digital storage space was widely recognized as an inherent concern in the computer arts, and minimizing the amount of encoded information in a given multimedia presentation would have been readily evident. The provision for a short string, (e.g., eight or ten numbers) which effects the same information transfer functionality as a much longer URL or product identification designation and network address would have been obvious to one of ordinary skill in the art at the time the invention was made. See, inter alia, Hudetz, Column 3, Lines 1-13, and Column 11, Lines 21-27.

24. In short, Portuesi disclosed a digital multimedia transmission incorporating codes used to effect information retrieval over a network at a user location, Sherman provided a method for audio signal embedding also effecting information transfer on a network, and Hudetz used

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centralized location of URL information for current, proper information delivery. The combination of these teachings, and any/all modification of the Portuesi base system with the remaining teachings would have been obvious to one ordinary skill in the art at the time of invention since all the teachings reside in the same art of network information transfer, and each modular, functional concept elaborated on similar concept(s) provided in the other references.

25. In regard to this “common network” discussion, it is noted that the provision for all the nodes of this combined system to be uniquely addressable, identifiable, and communicate using identical methodology (e.g., protocol usage), would have been a natural extension to the provided express teachings, minimally, to effect communication between system elements. This “integration” and/or “rearrangement” of modular parts falls well within the reasonable breadth of MPEP 2144.04(V).

26. As a general matter, not only the specific teachings of a reference but also reasonable inferences which an artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and *In re Sherpard*, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*, 309 F.2d 738, 226 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 738, 1385 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, 193 USPQ 545 (CCPA 1977). Lastly, *In*

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*re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), clearly states “any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, reconstruction is proper”. In the instant case, the provision for the media assembler, media transmitter, media receiver, and media interpreter being present on the same logical/physical/common network, it would have been obvious to implement the methodology set forth in both teachings (Palmer and Watanabe) in an arbitrary type of network system effecting delivery of media and URL address(es) to end devices. The provision for a “common” network, where all nodes communicate in the same fashion with one another, is a trivial matter of integration and a minimal rearrangement of parts, and would have been obvious to one of ordinary skill in the art at the time of invention. See MPEP § 2144(V)(B).

27. The claimed invention was disclosed by this combination of teachings and the knowledge readily available to one skilled in the art, and so, claims 1-5, 7-8, 10-14, 16-17, and 19-20 are rejected.

### ***Claim Objections***

28. Claims 9 and 18 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. It has been previously asserted, numerous times, that the detail of the system component interaction of the recited functionality set forth in this claim is sufficient to distinguish over the prior art of record.

***Response to Arguments***

29. The arguments presented by Applicant in the response, received on 8/4/2004, are not considered persuasive.

30. Applicant asserts the primary point of novelty relates to all the device(s) being resident on a common network, using a common communication protocol for information exchange. In response to Applicant's arguments, the recitation has not been given substantial patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

31. In regard to this "common network" discussion, it is noted that Palmer calls only for "a transmitter" and "broadcasting [multimedia]", not specific network types necessarily in accordance with the preferred embodiment expressly disclosed in the best mode. See Palmer, Column 2, Lines 57 through Column 3, Line 43. The bottom line remains, in order for terminals to communicate (bidirectionally), they must reside on a "common" network. In fact, the ability to communicate on the network was a criterion for being a network node, as well as utilizing a network level address. While Applicant attempts to confuse the issue of active network participation and/or non-inclusion, it is noted that a terminal/node may be a member of multiple logical networks concurrently, i.e., multiple logical network designations may exist for a



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particular node. A network level address was notoriously well known and widely understood in the art as a unique address for routing, delivering, and filtering information, e.g., layer 3 in the ISO OSI logical network model. Lastly, the “Internet”, a global communications network, inherently utilized a network level address, e.g., Internet protocol IPv4 or IPv6 address, *identifying each node as a member of the network*. In order for communication to occur, node(s) on these logical networks MUST use a network level address to effect the routing of information to/from that device. Thus, the inclusion of all the devices within this network “domain” clearly indicated a “common” network which the machines communicated over. Distinction on this basis is not persuasive, since, minimally, Watanabe specifically provided this functionality “applied to any system which can transmit and receive an audio signal” (inter alia, Column 9, Lines 53-56), “as software to realize the foregoing processing procedure that is applied to a personal computer having both of the audio signal receiving function and the function for accessing to the web site and displaying web information” (inter alia, Column 11, Lines 38-46), “[it] can be applied to any system so long as it can record and reproduce an audio signal...[using] any audio signal recording medium” (inter alia, Column 13, Lines 6-16), and “a similar effect will be obtained by the invention even in case using any signal so long as it can be transmitted and received as an audio signal” (Column 19, Lines 2-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made, when provided the teachings above, minimally, in combination with notoriously well known multimedia (video and/or audio) file storage and delivery over a network, that the source of any audio data, the audio transmitter, the audio receiver, the audio URL/code extractor(s), code to URL lookup database, and URL information display device(s), all reside on the same computer network, for

example the Internet. Also consider, all these functional elements may reside on the same computer (as expressly taught by Watanabe), itself inherently a part of the same network being used to obtain URL information. This logical commonality was inherent and required in order to allow machine addressing, and routing of requests or information to the terminals. Further provision for unique addresses for each terminal/node in the network was inherent. Otherwise, the physical routing of information was impossible. In short, if the terminals communicated using the network, they necessarily reside on the same logical network.

32. Distinction on this basis is not persuasive, since, minimally, Watanabe specifically provided this functionality “applied to any system which can transmit and receive an audio signal” (inter alia, Column 9, Lines 53-56), “as software to realize the foregoing processing procedure that is applied to a personal computer having both of the audio signal receiving function and the function for accessing to the web site and displaying web information” (inter alia, Column 11, Lines 38-46), “[it] can be applied to any system so long as it can record and reproduce an audio signal...[using] any audio signal recording medium” (inter alia, Column 13, Lines 6-16), and “a similar effect will be obtained by the invention even in case using any signal so long as it can be transmitted and received as an audio signal” (Column 19, Lines 2-5). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made, when provided the teachings above, minimally, in combination with notoriously well known multimedia (video and/or audio) file storage and delivery over a network, that the source of any audio data, the audio transmitter, the audio receiver, the audio URL/code extractor(s), code to URL lookup database, and URL information display device(s), all reside on the same computer network, for example the Internet. Also consider, all these functional elements may reside on the

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same computer (as expressly taught by Watanabe), itself inherently a part of the same network being used to obtain URL information. This logical commonality was inherent and required in order to allow machine addressing, and routing of requests or information to the terminals. Further provision for unique addresses for each terminal/node in the network was inherent. Otherwise, the physical routing of information was impossible. In short, if the terminals communicated using the network, they necessarily reside on the same logical network.

33. All this being said, the recitation of “commonality” of the network, and the state of all functional devices being a logical part of this logically designated network, will not be held as the novel feature of this claimed invention. As a general matter, not only the specific teachings of a reference but also reasonable inferences which an artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and *In re Shepard*, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985).

Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*, 309 F.2d 738, 226 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 738, 1385 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, 193 USPQ 545 (CCPA 1977). Lastly, *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), clearly states “any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only

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knowledge which was within level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper".

In the instant case, the provision for the media assembler, media transmitter, media receiver, and media interpreter being present on the same logical/physical/common network, it would have been obvious to implement the methodology set forth in both teachings (Palmer and Watanabe) in an arbitrary type of network system effecting delivery of media and URL address(es) to end devices. The provision for a "common" network, where all nodes communicate in the same fashion with one another, is a trivial matter of integration and a minimal rearrangement of parts, and would have been obvious to one of ordinary skill in the art at the time of invention. See MPEP § 2144(V)(B).

34. Applicant has not seasonably challenged the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action, i.e. storage of audio, video, and embedded coded information in a digital file (or set of digitally stored files), and the delivery (including file transfer and streaming of audio data) in a computer networking environment was well known in the art at the time the invention was made, are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

***Conclusion***

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

36. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, Jr. can be reached at 571-272-3925. The fax phone number for the organization where this application or proceeding is assigned remains 703-872-9306.

38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON  
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PRIMARY EXAMINER

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